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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/812,181	03/19/2001	Dadong Wan	5222.00126	8231

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EXAMINER

KIM, AHSHIK

ART UNIT PAPER NUMBER

2876

DATE MAILED: 04/10/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/812,181

Applicant(s)

WAN ET AL.

Examiner

Ahshik Kim

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on 02/07/02 (request for reconsideration).
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☐ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Request for Reconsideration*

1. Applicant's request for reconsideration is received 7 February 2002. Examiner  
5 appreciates applicant's correction on the identification of application as 09/812,181. Although  
last Office Action and the accompanying forms (paper #6) contained incorrect serial number  
(09/812,281), the application was reviewed on its merits, and no part of Office Action (paper #6)  
warrants any change due to this inadvertent error.

### *Claim Rejections - 35 USC § 102*

10 The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the  
basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

15 (b) the invention was patented or described in a printed publication in this or a foreign  
country or in public use or on sale in this country, more than one year prior to the date of  
application for patent in the United States.

2. Claims 1 – 6, 12 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by  
Tracy et al. (US 6,199,753).

20 Tracy teaches a system and method for in-store or remote (Internet) shopping comprising  
a mobile terminal 70 (col. 4, lines 1 – 8), including Radio Frequency tag and scanner 75 (col. 3,  
lines 31 – 38), which interacts with a central host through wireless or local area network (col. 4,  
lines 61 – 67). The central host 14 keeps track of product information (col. 5, line 67 – col. 6,

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line 80 and customer information (col. 6, line 66 – col. 7, line 8) in the database. Selection of items and scanning them are recorded in real-time (col. 8, lines 16 – 25).

***Claim Rejections - 35 USC § 103***

5           The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

10           (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15           This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

20           3.       Claims 7 – 10, 11 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tracy et al. (US 6,199,753) in view of Bezos et al. (US 6,029,141). The teachings of Tracy have been discussed above.

25           Tracy fails to specifically teach or fairly suggest linking referring customer and referred customer by the product and rewarding the referring customer.

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Bezos teaches Internet-based referral system (Figure 1) wherein bonus/commission is awarded to the referring customer (col. 1, line 62 – col. 2; Abstract). The data structure links a referring customer, a referred customer and products together (col. 1, lines 48 – 65) where the record can be identified, retrieved and updated by a key field (i.e., a referral source or a product).

5 In view of Bezos' teaching, it would have been obvious to an ordinary skill in the art at the time the invention was made to employ an old and well-known referral system to the teachings of Tracy in order to increase sales and expand customer base. By rewarding the customers with a reward system, customers are further motivated to refer a product to fellow shoppers or to bring new customers into the store. Furthermore, the store can use the  
10 information to track purchase trends of a customer(s), or identify best/worst selling items and adjust marketing plans accordingly, and thus an obvious expedient.

Re claim 9, Tracy teaches rewarding customers with discount coupons (col. 12, lines 51+).

### ***Response to Arguments***

15 4. Applicant's arguments filed 07 February 2002 have been fully considered, but they are not persuasive.

Applicant argues that Tracy does not teach "embedded" identification code. Examiner notes that it is well known in the art that the indicia such as barcode can be imprinted, embossed, etched or engraved depending on the nature of the product to be labeled. These are various  
20 methods of "embedding the tag to an item". CDs, books and other permanent articles usually have the code engraved/embedded thereon. Food products and other items in the supermarket contain the indicia imprinted on the wrapper (barcode label is not separate label applied by the

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retailer). Accordingly, when an item is identified by an indicia, the examiner contends that the indicia (or integrated tag) is permanent to the extent the character of the product allows (i.e., permanent items such as books would retain the code permanently and the code on food products or other perishable items would last until the products are consumed). Moreover, Tracy does not teach any additional modification of the label except for generating store specific labels for items such as deli products, and thus suggest that label applied by the manufacturers as described above would be used in a conventional retail environment. In view of the above, Tracy meets "embedded code" in the claims.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the primary reference to Tracy and the secondary reference to Bezos are directed to a system and method for retail transactions having the Internet as a component part. In addition to Tracy's coupon downloading over the Internet, further incorporating well-known customer reward system with bonus points or referral bonus as taught by Bezos are well within the ordinary skill in the art to increase sales and reward the customers.

For the reasons stated above, the Examiner believes that a proper prima-facie case of obviousness has been established. Therefore, the Examiner has made this Office Action final.

### *Conclusion*

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

5 MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,  
10 however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

I. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Grimes et al. (US 5,859,414); Palti (US 5,700,998) a customer information terminal in retail environment and embedded code on a product.

15 II. Any inquiry concerning this communication or earlier communications from the examiner should be directed to *Ahshik Kim* whose telephone number is (703)305-5203. The examiner can normally be reached between the hours of 6:00AM to 3:00PM Monday thru Friday.

20 If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee, can be reached on (703) 305-3503. The fax number directly to the Examiner is (703) 746-4782. The fax phone number for this Group is (703)308-7722, (703)308-7724, or (703)308-7382.

25 Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [ahshik.kim@uspto.gov].

30 *All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.*

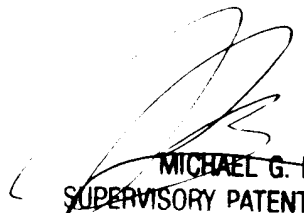
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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.

5

Ahshik Kim  
Patent Examiner  
Art Unit 2876  
March 11, 2002

10



MICHAEL G. LEE  
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